

### **REMARKS**

The Office Action dated February 2, 2006, has been received and carefully noted. The above amendments and the following remarks are submitted as a full and complete response thereto.

By this Amendment, claim 1 has been amended. No new matter is presented. The amendments to the claims do not narrow the scope of the claims but merely clarify features of the invention previously existing in the claims. Claims 1-3 are pending and respectfully submitted for consideration.

### **Rejections Under 35 U.S.C. § 112**

Claims 1-3 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Office Action took the position that the limitation "mounting the plurality of parts" did not recite where the parts were mounted to. The Applicant respectfully disagrees. Claim 1, line 1, recites, "A process for mounting a plurality of parts to a cable". As such, the limitation "mounting the plurality of parts" has antecedent basis in line 1. However, in order to clarify claim 1, the Applicant has repeated in claim 1 that the plurality of parts are mounted to the cable. The amendment to claim 1 does not narrow the scope of the claim. In view of the amendments, the Applicant respectfully requests withdrawal of the rejection.

### **Rejections Under 35 U.S.C. § 102**

Claims 1-3 were rejected under 35 U.S.C. § 102(b) as being anticipated by Inoue et al. (U.S. Patent No. 4,347,651, "Inoue"). Claims 2 and 3 depend from claim 1. The

Applicant traverses the rejection and respectfully submits that claims 1-3 recite subject matter that is neither disclosed nor suggested by Inoue.

Inoue discloses a connection wire manufacturing system in which a number of pairs of press-connecting terminals are formed in a hoop material, each being coupled at the heads with each other. The hoop material with the pairs of press-connecting terminals is transferred to a press-connecting step where those pairs of terminals are separated into individual pairs of terminals and those individual ones are press-connected to connection wires with given lengths properly prepared into a continuous connection wire line which is allowed to be taken up by a take-up drum. See Abstract of Inoue.

Claim 1, as amended, recites in part, "A process for mounting a plurality of parts to a cable comprising...marking the cable with information for the mounting of each of the parts before the mounting of the parts." In contrast, Inoue is directed to "a system for manufacturing connection wires to interconnect devices in an electric control board, a switch board, a distribution board and the like". See column 1, lines 7-10 of Inoue. The system of Inoue includes a marking unit which marks characters and signs as wire connection information on both end portions of each wire. See column 7, lines 10-13 of Inoue. Specifically, the wire connection information includes a wire number, connecting device position, and the terminal number of the connecting device. See column 1, lines 16-19 of Inoue. The wire's wiring information (wire connection information) is "necessary for a wiring and connecting work of the wires". See column 3, lines 61-63 of Inoue. There is no additional disclosure in Inoue regarding the details of the wire

connection information, much less any disclosure that the information is for mounting parts to the wire.

Accordingly, the wire connection information marked on the wires in Inoue has a purpose of facilitating a wiring and connecting work of the wires which are connected between devices in an electric control board, a switch board, a distribution board and the like. Thus, Inoue does not disclose or suggest at least the feature of marking a cable with information for the mounting of each of the parts before the mounting of the parts, as recited in claim 1.

Claim 3 recites a process for mounting parts to a cable according to claim 1 or 2, wherein the step of marking is carried out at a step of cutting the cable into a predetermined length. In contrast, Inoue discloses that on completion of the character selection and the wire feed, the marking mechanism marks simultaneously the end with the specified designations. The marked cable 51 is fed so that the cutting position of the n-th and the (n + 1)-th cables comes to the center of cutting/stripping unit 10. See column 4, lines 63-68 of Inoue. As such, Inoue does not disclose that the step of marking is carried out at a step of cutting the cable into a predetermined length, because the cable is fed after it is marked. As such, Inoue fails to disclose or suggest at least the features of the step of marking being carried out at a step of cutting the cable into predetermined lengths, as recited in claim 3.

Claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated by Yazawa (Japanese Patent Publication No. 06-223639). The Applicant traverses the rejection and respectfully submits that claim 1 recites subject matter that is neither disclosed nor suggested by Yazawa.

Yazawa discloses a wire marked with information about a mating side. According to the English language Abstract, Yazawa discloses a wire 1 assembled into a device marked with information 2 about the mating side of the device, so that assembling error, or the like, can be prevented.

Claim 1, as amended, recites, mounting the plurality of parts to the cable in mounted positions and in mounted attitudes determined respectively for the parts and marking the cable with information for the mounting of each of the parts. The Office Action took the position that terminal 10 and equipment 11 in Fig. 3 of Yazawa were comparable to the claimed plurality of parts, and that “a plurality of parts (10, 11) are mounted to a cable and that marking the cable with information (See Fig. 1) for the mounting each of the parts [sic] is before the mounting of the parts.” See paragraph 6 of the Office Action. In contrast, terminal 10 is not mounted to the wire 1. As shown in Fig. 3, terminal 10 is attached to equipment 11. In addition, terminal 10 is not mounted to the wire in a mounted attitude determined respectively for the terminal 10. Further, Yazawa does not disclose that the wire 1 is marked with information for the mounting of the terminal 10.

Moreover, the Applicant respectfully submits that there are no markings on the wire 1 with information for the mounting of element 10 in Yazawa. The Japanese term corresponding to the “mating side information” in the English language Abstract of Yazawa is more correctly translated into “assembling point information”. In Fig. 1(b), the information in Japanese characters on the wire is translated into “TO BE CONNECTED TO NO. 1”. That is, the assembling point information merely shows a connecting point of another member to which an end portion of the wire itself should be

connected. Specifically, the markings indicated by reference numeral 2 are instructions for connecting the wire 1, not for the mounting of parts to the wire 1 in Yazawa. Thus, Yazawa does not disclose or suggest at least the feature of a cable marking with information for the mounting of element 10. Therefore, Yazawa fails to disclose or suggest at least the combination of features of mounting the plurality of parts in mounted positions and in mounted attitudes determined respectively for the parts, and marking the cable with information for mounting each of the parts, as recited in claim 1.


According to U.S. patent practice, a reference must teach every element of a claim in order to properly anticipate the claim under 35 U.S.C. §102. In addition, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628,631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “Every element of the claimed invention must be arranged as in the claim. . . [t]he identical invention must be shown in as complete detail as is contained in the patent claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989) (Emphasis added). Accordingly, claim 1 is not anticipated by Inoue and Yazawa, nor is claim 1 obvious in view of Inoue and Yazawa.

Claims 2 and 3 depend from claim 1. The Applicant respectfully submits that each of these claims incorporates the patentable aspects thereof, and is therefore allowable for at least the same reasons as discussed above. Accordingly, the Applicant respectfully requests withdrawal of the objections and rejections, allowance of claims 1-3, and the prompt issuance of a Notice of Allowability.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Dkt. No. 107348-00358.**

Respectfully submitted,



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